

REMARKS

Claims 21 through 49 were pending in the application. By this amendment, claims 21 and 43 have been amended. Reconsideration and withdrawal of the rejections is requested in view of the foregoing changes to the claims and the following remarks.

The following remarks are intended to address all of the grounds for rejecting the claims set forth in the pending Office Action.

I. Double Patenting

Claims 21, 25, 28, 32, 33, and 43 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32, 35, and 36 of copending Application Serial No. 10/734,547. In view of the provisional nature of the rejection, and without acceding to the Examiner's contention of commonality of claimed subject matter between the two applications, Applicant will respond to this rejection at such time that it is asserted non-provisionally.

II. Claim Rejections

A. Sonnenschein et al.

Claims 21-25 and 43-47 were rejected under 35 U.S.C. § 102(b) as being anticipated by Sonnenschein et al. (US 2001/0056282). In addition, claims 36, 37, and 40-42 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over the Sonnenschein publication. Without acceding to the grounds for rejecting the claims, Applicant responds as follows.

Claims 21 and 43 have been amended to recite a method for performing a medical procedure that includes the steps of advancing an overtube (claim 21) or a main body (claim 43) comprising a plurality of nested elements having mating contoured surfaces within the body, and that also includes:

transitioning the main body to a rigid state by imposing a load that clamps the contoured surfaces of adjacent nested elements together to thereby substantially fix the shape of the overtube in any desired configuration

Support for these limitations is provided throughout the specification, such as, for example, at paragraphs 0232-0233 and in FIGS. 35 and 36.

The Sonnenschein method, on the other hand, does not include the recited transitioning step that includes “imposing a load that clamps the contoured surfaces of adjacent nested elements together” because the Sonnenschein device does not include an overtube / main body comprising a plurality of nested elements having mating contoured surfaces. Instead, the Sonnenschein device includes a conventional endoscope steering and locking mechanism. (See, e.g., Sonnenschein at paragraphs 0162-0163).

Accordingly, because at least these elements recited in claims 21 and 43 are not disclosed, taught, or suggested by the Sonnenschein publication, the claims contain patentable subject matter over that publication. The rejections of these claims should therefore be withdrawn, and the claims allowed to issue. Moreover, because each of the other rejected claims depends from one or the other of claims 21 and 43, those other pending claims also contain patentable subject matter, and should be allowed to issue.

B. Sonnenschein in Combination

Claims 26-35, 48, and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sonnenschein publication in view of Kalloo et al. (US 2002/0022851). In addition, claims 38 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Sonnenschein publication in view of Reed (US 2003/0165887). Without acceding to the grounds for rejecting the claims, Applicant responds as follows.

Each of the rejected claims depends from one or the other of claims 21 and 43, each of which is patentable over the Sonnenschein publication for the reasons set forth above. Neither of the Kalloo or the Reed publications remedies the defects of the Sonnenschein publication. Accordingly, each of claims 26-35, 38-39, and 48-49 is patentable over the combinations of Sonnenschein, Kalloo, and Reed for the reasons set forth above.

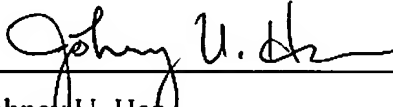
Amendment and/or cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented, but rather as an attempt to expedite allowance and issuance of the currently pending claims. No new matter has been added.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the appropriate fee and/or petition is not filed herewith and the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with this filing to **Deposit Account No. 50-3973** referencing Attorney Docket No. **USGINZ02512**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,



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